

REMARKS

Favorable consideration of this Application as presently amended and in light of the following discussion is respectfully requested.

Claims 28-41 are pending in the present Application. Claims 4, 10, 17 and 24 have been cancelled by previous amendments. The present Amendment cancels Claims 1-3, 5-9, 11-16, 18-23, and 25-27 without prejudice or disclaimer; and adds new Claims 28-41 without introducing any new matter.

The Official Action presents the following issues: Claims 1-3, 5-9, 11-16, 18-23, and 25-27 were rejected under 35 U.S.C. § 112, second paragraph, as not complying with the written description requirement. Claims 1-3, 5-9, 11-16, 18-23, and 25-27 stand rejected under 35 U.S.C. § 103(a) as being anticipated by Williams et al. (U.S. Patent 5,977,964, hereinafter "Williams") in view of Craig (U.S. Patent No. 5,790,176.)

In response, Claims 1-3, 5-9, 11-16, 18-23, and 25-27 are cancelled without prejudice or disclaimer, and new Claims 28-41 are presented. No new matter has been added.

In particular, new independent Claim 35 is now directed to an information retrieving apparatus configured to retrieve contents that is provided by a content provider. The apparatus includes, *inter alia*: an usage history generator configured to generate and update an usage history; a retrieving unit configured to retrieve content on a basis of said usage history; a content guide generator configured to generate a list of the retrieved content; and a content guide processor *configured to process the list of retrieved content on a basis of said usage history to generate a content guide that fits into a display screen to display the content guide at a same time*, when the content guide based on the entire list of retrieved content cannot be displayed in the display screen at the same time.

In accordance with the discussion of the background art in Applicants' specification, Electronic Program Guides (EPG) that are produced by broadcasting stations to guide a user

of a television through the available channels are very comprehensive. Therefore, it is not possible to display the entire EPG onto a display screen of a television (Specification, p. 2, ll. 18-22.) For a user to view the entirety of the retrieved content, a scrolling operation to scroll through all the retrieved content has to be performed. (Specification, p. 2, ll. 23-25.)

As explained in a non-limiting example of Applicants' disclosure regarding the Claim 35 features, it is possible that some programs that are included in the EPG can be selected for display based on a user's preference to limit the number of displayed content information, and subsequently displayed on a display screen, as long as they fit into one screen. (Specification, p. 22, ll. 12-16, see also p. 25, starting at l. 19, Fig. 7, steps SP21 and SP24.) The above discussion is for explanatory purpose only, and is not intended to limit the scope of the claims.

Applicants note that the features of the new claims find non-limiting support in Applicants' disclosure as originally filed. For example, the user history generator of independent Claim 35 finds non limiting support with reference to Fig. 4, steps SP1, SP2 and SP5, and at least in the specification at p. 16, ll. 5-25. The content guide generator configured to generate a list of retrieved content of Claim 35 finds non-limiting support at p. 22, l. 8-12, and in Fig. 7, step SP 20. Furthermore, the content guide processor configured to generate a content guide finds non-limiting support at p. 22, l. 12-16. Applicants' new dependent claims also find non-limiting support in the disclosure as originally filed. For example, dependent Claims 36-37 find non-limiting support in Applicants' Fig. 7, step SP 23, and in the specification at p. 23, ll. 12-20.

In response to the rejection of the claims under 35 U.S.C. § 103(a), Applicants respectfully request reconsideration of this rejection, and traverse the rejection, since independent Claim 35 now requires:

a content guide processor configured to ***process the list of retrieved content on a basis of said usage history to generate a content guide that***

fits into a display screen to display the content guide at a same time,
when the content guide based on the entire list of retrieved content cannot
be displayed in the display screen at the same time.

(Claim 35, portions omitted, emphasis added.) Turning now to the applied references, Williams describes a user monitored entertainment system which stores user profiles corresponding to user interaction. For example, as shown in Fig. 1, Williams' system 100 includes a television 102, a video recorder 106, a DVD player 114, in addition to other entertainment devices. (Williams, col. 3, ll. 47-59.) Williams uses a system controller 104 to control each component of the entertainment system 100. The controller 104 determines which user is currently using the system 100. In this way, the system 100 can be configured in accordance with a user profile stored in a profile database 100. (Williams, Fig. 2-4.) Based on the content of a user profile, such as preferences on channels, volume, etc. Williams' system can deliver dedicated content to the user. (Williams, col. 5, l. 52 to col. 6, l. 12.)

However, the cited passages of Williams fail to teach a content guide processor configured to process the list of retrieved content on a basis of said usage history to generate a content guide that fits into a display screen to display the content guide at a same time, as recited in Applicants' Claim 35. Williams merely explains that a schedule grid can be displayed, which can show the *current channel selections* for a user for a predetermined period of time. (Williams, col. 7, ll. 31-37.)

The applied reference Craig, used by the pending Office Action to form the 35 U.S.C. § 103(a) rejection, is directed to media server that forwards multi-media data over a telephone network in MPEG format. (Craig, Abstract.) Craig further explains that a media librarian 250 control the distribution of multi-media, an records usage data to calculate usage probabilities. (Craig, col. 8, ll. 56-66.) However, the cited passages of Craig are also silent on Applicants' Claim 35 features related to the content guide processor.

Therefore, even if the combination of Williams and Craig is assumed to be proper, the cited passages of the combination fails to teach every element of Claim 35. Specifically, the combination fails to teach the content guide processor that is configured to process the list of retrieved content on the basis of the usage history to generate a content guide that fits into a display screen, as required by Applicants' Claim 35. Accordingly, Applicants respectfully traverse, and request reconsideration of, this rejection based on these references.¹

Although Claims 28-34 are directed to a differing statutory class and/or are different in scope, it is respectfully submitted that the invention defined by these claims are also believed to patentably define over the cited passages of both Williams and/or Craig for at least the same reasons as discussed above with regard to new Claim 35, even if we assume that the combination of Williams and/ Craig is proper. Therefore, it is respectfully submitted that the invention defined by Claims 28-34 patentably defines over the asserted references.

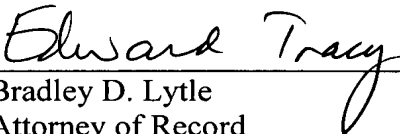
Consequently, in view of the present amendment, no further issues are believed to be outstanding in the present application, and the present application is believed to be in condition for formal Allowance. A Notice of Allowance for Claims 28-41 is earnestly solicited.

¹ See MPEP 2142 stating, as one of the three "basic criteria [that] must be met" in order to establish a *prima facie* case of obviousness, that "the prior art reference (or references when combined) must teach or suggest all the claim limitations," (emphasis added). See also MPEP 2143.03: "All words in a claim must be considered in judging the patentability of that claim against the prior art."

Should the Examiner deem that any further action is necessary to place this application in even better form for allowance, the Examiner is encouraged to contact Applicants' undersigned representative at the below listed telephone number.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.


Bradley D. Lytle
Attorney of Record
Registration No. 40,073

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 03/06)

Nikolaus P. Schibli
Registration No. 56,994

BDL:NPS\mca
I:\ATTY\NPS\21's\210146US\210146US-AM-OA-07.24.07.DOC

Edward W. Tracy
Registration No. 47,998